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From: Michele Morrow for Carrie Parker Legal Assistant to Cathrine K. Kinslow/jl	No. of Pages Including Cover Sheet: 10
Message:  Enclosed herewith: <ul style="list-style-type: none"><li>• Transmittal Document; and</li><li>• Reply Brief.</li></ul>	
Re: Application No. 09/442,791 Attorney Docket No: RSW990108	
Date: Wednesday, January 05, 2005	
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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Ims et al.

Serial No.: 09/442,791

Filed: November 18, 1999

For: Legacy Host System Hot Link  
Modeling and Navigation

36736

PATENT TRADEMARK OFFICE  
CUSTOMER NUMBER

§ Group Art Unit: 2157


§ Examiner: Najjar, Saleh

§ Attorney Docket No.: RSW990108

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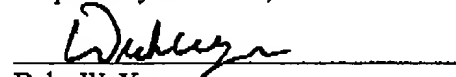
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Docket No. RSW990108

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 05 2005

In re application of: Ims et al.

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Group Art Unit: 2157

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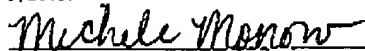
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By:

  
Michele Morrow

## REPLY BRIEF (37 C.F.R. 41.41)

This brief is in furtherance of the Examiner's Answer dated November 5, 2004.

No fees are believed to be required to file a Reply Brief. Any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF REPLY BRIEF.

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**RESPONSE TO EXAMINER'S ARGUMENT**

With reference to the Examiner's Answer, dated November 5, 2004, appellants respond as follows :

As to claim 1 (independent claim 1 is representative of independent claims 12 and 23 with regard to similarly recited subject matter), the Examiner's Answer states:

Himmel fails to teach the limitation of formatting the host screen from a non-markup language. Himmel does teach that FTP (file transfer protocol) and GOPHER sites exist for access on the Internet (see col. 1, lines 30-31). Himmel also discloses that the invention supports any browser, even back level browsers that may not support a particular language or version of the language, which became prevalent since the browser was written (see col. 7, lines 55-60). Himmel further discloses that Internet protocols other than HTML can be used and adapted to the teachings of the invention (see col. 9, lines 54-58).

However, Tada teaches a system and method to enable the automatic processing of non-HTML data such as e-mail data even if the user terminal has a browser that only supports HTML (see abstract; col. 1, lines 45-50). Tada teaches formatting the host screen from a non-markup language to a markup language (see col. 3, lines 10-12; col. 4, lines 45-50; col. 5, lines 27-41; col. 6, lines 1-15, Tada discloses that when he user submits an e-mail service request, non-HTML data (e-mail data) is converted to an HTML file which is represented by an embedded markup tag on a web page for the user selection and displayed by the browser.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Himmel in view of Tada so that non-HTML files such as e-mail are accessed by a HTML browser. One would be motivated to do so since retrieving e-mail represents a typical task in the Internet browsing experience.

Examiner's Answer dated November 5, 2004, pages 3-4. Applicants respectfully disagree. The above statements made by the examiner argue that because *Himmel* relates to browsers accessing sites on the Internet and *Tada* relates to browsers processing HTML/non-HTML data on the Internet, these references are properly combinable. This is clearly improper reasoning. The examiner is essentially stating that a reference that generally teaches browsers accessing or processing Internet sites or data could be combined with any other reference that teaches browsers accessing or processing Internet sites or data, regardless of the problems identified and solved in the different references.

The Examiner's Answer further states:

In response to the applicant's argument that there is no suggestion to combine the references . . . Himmel recognizes the existence of non-HTML data such as FTP (file transfer protocol) and GOPHER sites (see col. 1, lines 30-31). Himmel also

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discloses that the invention allows any browser, even back level browsers which may not support a particular language or version of the language which became prevalent since the browser was written to access Internet content (see col. 7, lines 55-60). Himmel further discloses that Internet protocols other than HTML can be used and adapted to the teachings of the invention (see col. 9, lines 54-58). Tada teaches a system and method to enable the automatic processing of e-mail data (non-HTML data) which represents Internet content even if the user terminal has a browser that is outdated and only supports HTML (see abstract; col. 1, lines 45-50). One of ordinary skill in the art would certainly find it obvious to modify Himmel in view of Tada so that e-mail (non-HTML data) is accessed by a HTML browser since retrieving e-mail represents a typical task in the Internet browsing experience.

Examiner's Answer dated November 5, 2004, pages 9-10. Appellants respectfully disagree. When each reference is considered as a whole, one of ordinary skill in the art would not combine *Himmel* with *Tada*, considering the problems recognized and solved.

*Himmel* is directed towards providing customized Internet content to a requesting client device using an intercepting agent. When a client device requests a file from a web server, the agent, typically located at the web server receiving the client request, intercepts the request. The agent then detects client device capability information about the requesting client device, such as display or memory capabilities. The client request is redirected to a Uniform Resource Locator (URL) according to the detected client device capability information to retrieve a version of the requested file. (*Himmel*, col. 2, lines 25-35). Thus, the *Himmel* agent addresses customizing of the presentation of a requested web page for a particular client.

In contrast, *Tada* is directed towards enabling the automatic processing of non-HTML data (e.g., email data) even if a user terminal has only a browser that handles HTML files. (*Tada*, col. 1, lines 46-49). An HTML file is requested using the WWW browser on a user terminal apparatus. An Internet connection service provider apparatus (Internet Service Provider) using the HTML file request as a trigger automatically acquires a user's e-mail and then converts the e-mail to HTML format for storage. If e-mail is present, a markup tag to the e-mail list is added to the requested HTML file and transmitted to the user terminal apparatus. When the user selects this tag, the Internet connection service provider apparatus retrieves the corresponding e-mail HTML file and returns it to the user. (*Tada*, Abstract). Thus, *Tada* provides deferred access to non-HTML data by allowing a link to email data that was converted to HTML format on the

requested HTML file. The user must select this link to access the converted data. (*Tada*, Figures 11A-11D; col. 6, lines 43-67).

In view of the above, there is no motivation to combine the teachings of *Himmel* with *Tada* in the manner alleged by the examiner. The mere fact that the prior art could be readily modified to arrive at the claimed invention does not render the claimed invention obvious; the prior art must suggest the desirability of such a modification. *In re Ochiai*, 71 F.3d 1565, 1570, 37 U.S.P.Q.2d 1127, 1131 (Fed. Cir. 1996); *In re Gordon*, 733 F.2d 900, 903, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Merely stating that the modification would have been obvious to one of ordinary skill without identifying an incentive or motivation for making the proposed modification is insufficient to establish a *prima facie* case.

*Himmel* is directed toward redirecting client Web requests to client-tailored web pages. The reformatting agent in *Himmel* merely teaches customizing the presentation of the web page. There is no need, let alone any suggestion, to convert non-markup language to a markup language to customize the presentation of a selected web page in *Himmel*.

Moreover, there is no suggestion in *Tada* of a need to integrate the *Tada* system with a web page customization system, such as that taught by *Himmel*. *Tada* has nothing to do with detecting the capabilities of a client device and customizing a web page according to the capabilities of the client device. *Tada* is concerned with providing a means to enable the automatic processing of non-HTML data (e.g., email data), regardless of whether the data to be processed is requested by the user (*Tada*, col. 1, lines 40-43). There is no need, let alone any suggestion in *Tada* to provide a client-tailored web page of the requested data to match the client's capabilities.

Data which is converted from non-markup language to markup language in *Tada* is provided to the user in a deferred manner, wherein the converted data is provided to the user via a link which the user must select to access the data. When a user requests a web page, *Himmel* provides the user an immediate response with a customized version of the requested data. Focusing only on this contrast, the Examiner claims that this distinction between *Tada*'s deferred access and *Himmel*'s immediate response is the basis for the Appeal to argue that there is no teaching or suggestion to combine the references. (Examiner Answer dated November 5, 2004, page 9). Within the context of the many differences already identified between *Himmel* and

*Tada*, the broad basis becomes apparent for stating that there is no teaching or suggestion to combine the references.

The alleged motivation to combine the references offered by the examiner is not based on the actual teaching of the references. Thus, the present invention is shown to not be obvious in view of the cited references, per *In re Beattie*, "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" See *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)).

In addition, the examiner may not make modifications to the prior art using the claimed invention as a model for the modifications. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783-1784 (Fed. Cir. 1992). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art has suggested the desirability of the modification." *Id.* In other words, unless some teaching exists in the prior art for the suggested modification, merely asserting that such a modification would be obvious to one of ordinary skill in the art is improper and cannot be used to meet the burden of establishing a *prima facie* case of obviousness. Such reliance is an impermissible use of hindsight with the benefit of applicant's disclosure.

As noted above, there is no teaching or suggestion in the references as to the desirability of including the features from the other references. As the examiner has failed to demonstrate any motivation or incentive in the prior art to combine and modify the references so as to achieve the claimed invention, the alleged combination can only be the result of impermissible hindsight reconstruction using applicant's own disclosure as a guide. As the present rejection is based completely on hindsight to the exclusion of what can be properly gleaned from the references by one of ordinary skill in the art, the rejection is improper and should be withdrawn.

Claims 3-8 and 10 are dependent claims depending from independent claim 1. Claims 14-19 and 21 are dependent claims depending from independent claim 12. Claims 25-30 and 32-33 are dependent claims depending upon independent claim 23. Applicants respectfully

submit that claims 3-8, 10-11, 14-19, 21-22, 25-30, and 32-33 are also patentable over *Himmel* and *Tada*, at least by virtue of their dependency on an allowable claim.

In view of the above, applicant respectfully requests withdrawal of the rejection of claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, and 32-33 under 35 U.S.C. §103.

As to independent claim 34, the Examiner's Answer states:

*Himmel* fails to teach the claimed invention limitation of a "macro bean." *Himmel* does teach that a java script or java program can be used to implement the snooping functionality of the server for identifying the client and the requested page (see col. 5, line 67; col. 6, line 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Himmel* by specifying the Java script / program as a macro bean since the same functionality of implementing a script to identify the client device and the requested web page is achieved. One would be motivated to do so since a script when executed, plays out the commands of a macro emulating the environment of the requesting client and runs the commands as if it was interacting directly with a user.

Examiner's Answer dated November 5, 2004, pages 6-7.

Independent claim 34 and its dependent claims 36 and 37 are also patentable over the cited references because one of ordinary skill in the art would not be motivated to modify *Himmel* and *Tada* in the manner required to form the solution discussed in the claimed invention when the problems addressed by the two references are reviewed when considering each reference as a whole, as shown above. In addition, these claims include other patentable features from those in the claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, and 32-33.

The arguments made with respect to claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, and 32-33 apply to the claims 34, 36, and 37 as well. As mentioned previously, *Himmel* and *Tada* are not properly combinable when each reference is considered as a whole.

Furthermore, with regard to independent claim 34, *Himmel* and *Tada* fail to teach or suggest all elements of the claim. Independent claim 34 recites the additional feature of having a macro bean provide navigation between screens within a legacy host system. Neither *Himmel* nor *Tada* teach this feature. The section in *Himmel* that the Examiner equated with a macro bean states, "This client-snooper can be written as a client side JavaScript HTML page, java program,

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or java applet to identify the client device.” (*Himmel*, column 5 line 67 to column 6 line 1)

Independent claim 34 of the present invention reads as follows:

A macro bean for providing navigation between screens within a legacy host system, the macro bean comprising:  
first instructions for receiving a request for a requested host screen from a legacy host system;  
second instructions for determining the current host screen; and  
third instructions for navigating to the requested host screen, wherein intermediate host screens between the current host screen and the requested host screen are unsent to a client;  
fourth instructions for formatting the host screen into a formatted host screen from a non-markup language to a markup language, wherein the formatted host screen displays selectable links to other screens within host system; and  
sending the formatted host screen to the client.

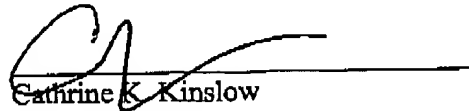
Even if the Java script / program in *Himmel* was specified as a macro bean, it would be a macro bean for identifying a client device, not a macro bean providing navigation between screens within a legacy host system. In *Himmel*, the Java program does not determine the current host screen, navigate to the requested host screen, format the host screen from a non-markup language to a markup language, or send the host screen to the client. Additionally, the context for functioning differs. The Java program in *Himmel* sends a snoop to the client machine where it functions within the client machine to identify the client type, in contrast to the present invention’s macro bean navigating within the host system. Neither the functionality nor the context of the present invention’s macro bean is found in the *Himmel* Java program’s functions or context. Thus, *Himmel* and *Tada* fail to teach having a macro bean provide navigation between screens within a legacy host system, as recited in claim 34 of the present invention.

Claims 36 and 37 are dependent claims depending from independent claim 34. Applicants respectfully submit that claims 36 and 37 are also patentable over *Himmel* and *Tada*, at least by virtue of their dependency on an allowable claim.

In view of the above, applicant submits that claims 34, 36, and 37 are not obvious in view of the *Himmel* and *Tada* references.

**CONCLUSION**

In view of the comments above, appellants respectfully submit that the rejections of claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, 32-34 and 36-37 are overcome. Accordingly, it is respectfully urged that the rejection of claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, 32-34 and 36-37 not be sustained.



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